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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/362,052	07/28/1999	YOICHI MATSUYAMA	35.C13703	6357

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HU, JINSONG

ART UNIT	PAPER NUMBER
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2154

3

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

pph

Office Action Summary

Application No.

09/362,052

Applicant(s)

MATSUYAMA ET AL.

Examiner

Jinsong Hu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

1. Claims 1-28 are presented for examination.
2. It is noted that although the present application does contain line numbers in the specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. Claims 2, 11 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - A. The claim language in the following claims is not clearly understood.
 - i. As per claim 2, lines 2-5, it claimed that "said print setup information" is based on the "information included in said print request", in claim 1, lines 6-8, it claimed that "generating print request information" based on "said print setup information". It is hard to understand the conflict claim language. Correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 7-8, 10-14, 16-17, 19-23, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuyama (US 6,330,068 B1).

6. As per claim 1, Matsuyama teaches the invention as claimed including an information processing apparatus [103, Fig. 1] for communicating with an external apparatus [104, Fig. 1] via the Internet [col. 7, lines 15-21], comprising:

acquisition means for acquiring, via the Internet, print setup information from said external apparatus [col. 7, lines 36-42, information for operating the system];

generation means for generating print request information based on said print setup information acquired by said acquisition means [col. 39, lines 10-17]; and.

print request means for establishing communication, via the Internet [col. 7, lines 15-21], with said external apparatus for the transmission of said print request information [col. 39, lines 5-9].

7. Matsuyama does not specifically teach that the print request information is generated by said generation means before said print request means establishes communication with said external apparatus. It would have been obvious to a person of ordinary skill in the art that generating request before communicating with said external apparatus in Matsuyama's system since the information processing apparatus in Matsuyama's system stored the information for operating the printers.

8. As per claim 2, Matsuyama teaches that the print setup information is information describing an output style available at a printer for the performance of printing based on the information included in said print request [col. 7, lines 36-42, information for operating the system].

9. As per claims 3-5, Matsuyama teaches the invention substantially as claimed in claim 1. Matsuyama also teaches the step of deriving the expenses that are to be incurred to obtain the printing results [payment, Fig. 6]. However, Matsuyama does not specifically teach the steps of updating the setup information and expense information after establishing communication with said external apparatus. It would have been obvious to a person of ordinary skill in the art that to retrieve the latest system information in Matsuyama's system in order to supply the accurate information to users.

10. As per claim 7, Matsuyama teaches that the generating means is a peruser plug-in function, and employs the application communication function of an operating system to generate said print request information for a document that is currently being edited by a document editor [101, Fig. 1; col. 10, lines 31-43].

11. As per claim 8, Matsuyama teaches that a dial-up connection is used to connect said external apparatus to the Internet [col. 7, lines 20-21].

12. As per claims 10-14 and 16-17, since they are method claims of claims 1-5 and 7-8, they are rejected under the same basis as claims 1-5 and 7-8.

13. As per claims 19-23 and 25-26, since they are computer program claims of claims 1-5 and 7-8, they are rejected under the same basis as claims 1-5 and 7-8.

14. As per claim 27, since it is a computer program claim of claim 1, it is rejected under the same basis as claim 1.

15. Claims 6, 15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuyama (US 6,330,068 B1) in view of Sasaki et al. (US 6,351,317 B1).

16. As per claim 6, Matsuyama teaches the invention as claimed in claim 1. Matsuyama does not specifically teach that the print setup information is HTML data generated for said external apparatus, and said external apparatus manages said print setup information for each output shop.

17. Sasaki on the other hand teaches a method discloses that the print setup information is HTML data generated for said external apparatus, and said external apparatus manages said print setup information for each output shop [col. 15, lines 8-43].

18. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Matsuyama and Sasaki because utilizing Sasaki's HTML format print setup information in Matsuyama's system would improve the capability Matsuyama's system by allowing user printing the desired web page.

19. One of ordinary skill in the art would have been motivated to modify Matsuyama's system with HTML format setting information in order to improve the capability of the system.

20. As per claim 15, since it is a method program claim of claim 6, it is rejected under the same basis as claim 6.

21. As per claim 24, since it is a computer program claim of claim 6, it is rejected under the same basis as claim 6.

22. Claims 9, 18, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. (US 6,351,317 B1).

23. As per claim 9, Sasaki teaches the invention substantially as claimed including an information processing apparatus [208] comprising:

network browsing means for communicating with a server across a network and for displaying data received from said server [col.13, lines 58-65];

acquisition means for acquiring information about said server and for storing said information at a client computer [col.13, line 66- col. 14, line 3]; and

display data generation means having a function for employing said information held by said client computer and separately acquired HTML template data to generate HTML data that said network browsing means is capable of displaying [col. 14, lines 4-23].

24. Sasaki does not specifically teach a common gateway interface (CGI). However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made that utilizing a CGI function in Sasaki's system because CGI is a well-known script in the art that executed in the system for user browsing the HTML file.

25. As per claim 18, since it is a method program claim of claim 9, it is rejected under the same basis as claim 9.

26. As per claim 27, since it is a computer program claim of claim 9, it is rejected under the same basis as claim 9.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ando (US 6,384,930) discloses a printer control system; and

Shima (US 6,362,894 B1) discloses a network printer system.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (703) 306 – 5932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678. The fax number for this Group is (703) 308-9052. Additionally, the fax numbers for Group 2100 are as follow:

Official Faxes: (703) 746-7239


After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 305-3900.

Jinsong Hu

August 23, 2003


ZARNI MAUNG
PRIMARY EXAMINER